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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/466,400 12/17/99 FRIEDOW

M 10191/1172

026646  
KENYON & KENYON  
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NEW YORK NY 10004

MM91/0821

EXAMINER

LEON, E

ART UNIT

PAPER NUMBER

2833

DATE MAILED:

08/21/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/466,400	FRIEDOW ET AL.
	Examiner	Art Unit
	Edwin A. León	2833

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 13 July 2001.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-16 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-16 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

15) Notice of References Cited (PTO-892)

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

18) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

19) Notice of Informal Patent Application (PTO-152)

20) Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. Applicant's amendment filed May 10, 2001 in which Claims 1 and 3-5 and 12-13 have been amended and Claim 2 has been added, has been placed of record in the file as Paper No. 7.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Togashi (U.S. Patent No. 5,772,470). With regard to Claims 1 and 4, Togashi discloses a device for contacting an electrically operated apparatus, comprising: at least one terminal contact (bottom of Fig. 1) on a side of the apparatus, the at least one terminal contact (bottom of Fig. 1) being oriented parallel to an installation direction of the apparatus; and a plug (50) including at least one sleeve contact (11), the at least one sleeve contact (11) and the at least one terminal contact (bottom of Fig. 1) being adapted to be assembled together parallel to the installation direction and the at least

one sleeve contact (11) including two concentric sleeve contacts (11). See Column 5, Lines 6-13 and Figs. 1-5.

Togashi discloses the claimed invention except for the at least one terminal including two concentric terminal contacts, the two sleeve contacts connecting the two terminal contacts. It would have been an obvious matter of design choice to have the at least one terminal including two concentric terminal contacts, the two sleeve contacts connecting the two terminal contacts, since applicant has not disclose that this feature is a critical, patentably distinguishing feature and the invention would perform equally well with a single terminal contact (bottom of Fig. 1) as shown in Fig. 1 of Togashi.

With regard to Claim 3, Togashi discloses the sleeve contacts (11) are each in contact with the terminal contact (bottom of Fig. 1) on an outside circumference when joined together. See Column 5, Lines 6-13 and Figs. 1-5.

With regard to Claim 5, Togashi discloses insulation situated between the terminal contact (bottom of Fig. 1). See Column 5, Lines 6-13 and Figs. 1-5.

With regard to Claim 6, Togashi discloses the insulation includes an insulating sleeve composed of a plastic. See Column 5, Lines 6-13 and Figs. 1-5.

With regard to Claim 7, Togashi discloses a back wall (56) of the plug acts as a further insulation which, together with the insulation between the terminal contact (bottom of Fig. 1), form two contact chambers insulated from one another. See Column 5, Lines 6-13 and Figs. 1-5.

With regard to Claim 8, Togashi discloses the at least one sleeve contact (11) includes an interior sleeve contact and an exterior sleeve contact, a printed conductor of

the interior sleeve contact passing through a recess in the exterior sleeve contact. See Column 5, Lines 6-13 and Figs. 1-5.

With regard to Claim 9, Togashi discloses the at least one sleeve contact (11) includes a cylindrical segment. See Column 5, Lines 6-13 and Figs. 1-5.

With regard to Claim 10, Togashi discloses the at least one sleeve contact (11) having polygonal cross section. See Column 5, Lines 6-13 and Figs. 1-5.

With regard to Claim 11, Togashi discloses the at least one sleeve contact (11) has a diameter so as to overcome a predetermined contacting force when connected. See Column 5, Lines 6-13 and Figs. 1-5.

With regard to Claim 12, Togashi discloses the sleeve contacts (11) have inclined insertion guides. See Column 5, Lines 6-13 and Figs. 1-5.

With regard to Claim 13, Togashi discloses a plurality of punched grid conductors (101) connected to the plug (50). See Column 5, Lines 6-13 and Figs. 1-5 and 20-22.

With regard to Claim 14, Togashi discloses a first of the sleeve contacts (11) and a first of the punched grid conductors (101) are a one-piece unit, and a second of the sleeve contacts (11) and a second of the punched grid conductors (101) are a one-piece unit. See Column 5, Lines 6-13 and Figs. 1-5 and 20-22.

With regard to Claim 15, Togashi discloses the sleeve contacts (11) are formed by one of bending and folding the punched grid conductors (101). See Column 5, Lines 6-13 and Figs. 1-5 and 20-22.

4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Togashi (U.S. Patent No. 5,772,470) in view of Beloritsky (U.S. Patent No. 6,036,540). With

regard to Claim 15, Togashi discloses the claimed invention except for the sleeve contact being configured to substantially surround a respective one of the terminal contacts when the at least one sleeve contact and the at least one terminal contact are assembled.

Beloritsky discloses a contact (10) which surrounds a terminal contact (25). See Figs. 1-3.

Thus, it would have been obvious to one with ordinary skill in the art to modify the device of Togashi by including a contact which surrounds a terminal contact as taught in Beloritsky to improve the electrical connection between both contacts.

#### ***Response to Arguments***

5. Applicant's arguments filed May 10, 2001 have been fully considered but they are not persuasive. In response to applicant's argument regarding Claim 1 that the references do not show the at least one terminal including two concentric terminal contacts, the two sleeve contacts connecting the two terminal contacts, it is the Examiner's opinion that the invention would work the same with a single terminal contact as shown in Fig. 1 of Togashi.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, In this case, it would have been obvious to one with ordinary skill in the art to modify the device of Togashi by including a contact which surrounds a terminal contact as taught in Beloritsky to improve the electrical connection between both contacts.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin A. León whose telephone number is (703) 308-6253. The examiner can normally be reached on Monday - Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (703) 308-2319. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

*P. Bradley*  
Paula Bradley  
Supervisory Patent Examiner  
Technology Center 2800